

The lubricants recited in claims 69 also find support on pages 6-19 of the written description whereas the third full paragraph on page 32 supports the claim to a two mole ethoxyxylate of isostearyl alcohol as one of the other lubricants.

The Rejection Under 35 U.S.C. § 112 First Paragraph and Traverse

The Examiner rejects claim 58, 61, 62, 67 and 68 under 35 U.S.C. § 112 first paragraph as containing subject matter which the applicant did not describe in the specification in such a way as to reasonably convey to one skilled in the art that at the time he filed the application, he had possession of the claimed invention. Applicant traverses the rejection and requests further consideration reexamination.

The Examiner maintains the rejections of claims 61 and 62 based on reasons of record in the October 23, Office Action, specifically arguing that the written description does not support the application of lubricants to a wire. Applicant traverses the rejection for the same reasons set forth in the November 29, Appeal Brief, pages 4-8, incorporated herein by reference.

The Examiner also argues that the statement on pages 31 and 32 of the written description that "the lubricant composition is then dried to remove water . . . This removes substantially all of the water introduced in the first part of the process" does not support the "subject matter of claim 58 that the 'superabsorbent polymer . . . desorbs water [when] the coating is dried.'" (March 28, Office Action, paragraph bridging pages 2 and 3). Furthermore, the Examiner finds that pages 17 and 18 directed to "binder systems" does not support the "subject matter of claim 67 and 68 that the 'coating further [comprises] a binder.'" (March 28, Office Action, page 3, first full paragraph).

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Again, applicant traverses the rejections for the same reasons set forth on pages 4-8 of the November 29 Brief on Appeal incorporated herein by reference. The Examiner in commenting on the applicant's description of the binder in the Appeal Brief "did not find any explicit disclosure to any binders at pages 19, 20 and 21 and applicants [sic] did not particularly set forth or point out any such paragraph as to the location of said binders." (March 28, Office Action page 3, first full paragraph).

Applicant again relies on pages 17-21 for support of the binders now claimed. The paragraph bridging pages 17 and 18 refers to "various thermosetting and thermoplastic and curable binder systems including phenolic, vinyl, acrylic, alkyd, polyurethane, silicone and, epoxy resins." The written description then states, "It would be an advantage, however, to provide a novel binder that performed in the same way or improved on the function of these binders." (Written description, paragraph bridging pages 17 and 18) (emphasis added).

The written description goes on to note on page 19, second paragraph "that there is a need for additional materials that will provide the same advantage as those of the related art as well as additional advantages and also materials that will overcome some of the various disadvantages of the related art." (Emphasis added) The fourth paragraph on page 19 of the written description then states that "these and other advantages are obtained according to the present invention, which is the provision of a composition and a process to enhance the various advantages of the related art and which also substantially obviate one or more of the limitations and disadvantages of the described prior compositions of matter and processes." (Emphasis added)

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The prior art as described in the application related to various binders such as polyurethane binders, and the application goes on to describe that the present invention "improved on the function of these binders." Clearly this comprises a description of using the binders of the prior art in combination with the superabsorbent polymers and lubricants broadly described in the first paragraph on page 20 of the written description.

The law does not require verbatim disclosure, just that the applicant discloses the invention in a way to show that he had possession of the subject matter of the invention at the time he filed the application. Applicant has met that requirement.

The Rejection Under 35 U.S.C. § 102 and Traverse

The Examiner rejects claims 58-60 and 66-68 under 35 U.S.C. § 102(b) as clearly anticipated by Hopkins et al., U.S. Patent No. 5,362,788 ("Hopkins") combined with the Merck index and admitted prior art.

Hopkins describes a method for combining a superabsorbent polymer with a "matrix" material such as cellulose acetate, methacrylate polymers, polyvinyl acetate, copolymers and combinations of these polymers. (Hopkins, col. 1, lines 29-35; col. 2, lines 10-19). The "matrix" material further includes "plasticizers" (col. .2, line 23) which, the skilled artisan knows increases the flexibility of the matrix material, i.e., cellulose acetate, methacrylate polymers, polyvinyl acetate, copolymers and combinations of these polymers.

A "matrix" does not disclose or suggest a "substrate." Webster's Ninth New Collegiate Dictionary defines "matrix" as a "material in which something is enclosed or embedded (as for protection or study)." Hopkins obviously uses the matrix

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to envelop particles of the superabsorbent polymer in describing the invention as "providing a matrix material in a suitable solvent; mixing particles of a superabsorbent polymer into said solutioned [sic] matrix material to form a suspension; homogenizing the suspension; and removing the solid from the suspension." (Col. 1, lines 30-35) (Emphasis added). The foregoing description clearly conveys that Hopkins only dissolves the matrix in a solvent and not the superabsorbent polymer, but rather mixes particles of the superabsorbent polymer into the solution of the matrix in the solvent to form a "suspension."

In fact, Hopkins defines the term "suspension" as a "mixture containing a substantially uniform distribution of solute and particulate matter through the liquid carrier." (Col. 2, lines 30-33). There can be no doubt that Hopkins by referring to the "particles of a superabsorbent polymer" in this section, further confirms the end product comprises a matrix of materials such as cellulose esters that envelop particles of superabsorbent polymer.

The subsequent disclosure relative to the plasticizers clearly teaches that these plasticizers combine with the matrix material and not with the superabsorbent polymer. Hopkins in this regard states that the "matrix material may further comprise additives [such as] plasticizers" (Col. 2, lines 19-23) (emphasis added). Here, Hopkins clearly describes he plasticizes the "matrix" and not the superabsorbent polymer.

Thus the addition of plasticizers such as glycerin to the Hopkins composition addresses the need to plasticize the matrix material and in no way would teach a person with ordinary skill in the art that the plasticizers combine with the superabsorbent polymer.

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The examples describe adding a solution of cellulose acetate in acetone in combination with a superabsorbent polymer (Sanwet® IM-1000) and glycerin (a plasticizer) to a high shear mixing apparatus to form a solution, which when subsequently cast into films and air dried retains a 0.9% saline solution. Although Hopkins combines a superabsorbent polymer with acetone in the examples, the skilled artisan knows that acetone will not dissolve superabsorbent polymers such as Sanwet® IM-1000, and that in essence the combination of acetone and superabsorbent polymer comprises a slurry of particles of the superabsorbent polymer in the acetone in order to facilitate introducing it into the solution of cellulose acetate. Furthermore, Hopkins had no awareness of any lubricating properties of the combination of cellulose acetate or other matrix materials with a superabsorbent polymer.

Hopkins fails to teach a utility for the combination of superabsorbent polymer and matrix material. The reference describes the matrix material as having good absorbent and retention properties and further immobilizes the superabsorbent polymer. (Col. 1, lines 18-19). Hopkins further indicates the matrix materials "can be made porous as would be desirable for filtration membranes." (Col. 1, line 66, Col. 2, lines 7-9).

The reference constitutes nonanalogous art in that it fails to teach anything about the formation of a lubricant or the use of the disclosed material for the purpose of lubrication. Applicant no longer relies on the "consisting essentially of" terminology in the claims to distinguish Hopkins.

The Merck Index does not enhance the teaching of the use of glycerin by Hopkins as a plasticizer, even though the Merck index describes glycerin has lubricant properties. The glycerin of Hopkins functions to plasticize the matrix and Hopkins

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neither teaches nor suggests that the plasticizer can or does in fact leave the cellulose acetate to combine with the superabsorbent polymer.

The teachings of Brannon-Peppas only refer to art known superabsorbent polymers, and standing by itself, or even taken with the Hopkins teaching or the Merck index teaching do not convey to a person with skill in the art that Hopkins obtains a superabsorbent polymer combined with a lubricant.

The Examiner combining the teachings of Hopkins, The Merck Index and Brannon-Peppas can stand as a 35 U.S.C. § 102(a) rejection only if the Examiner employs the references to enhance the teaching of the principle reference, Hopkins. To combine the references with one another, utilizing the teachings of each to show the various elements of the prior art would require the Examiner to make the rejection under 35 U.S.C. § 103, which she has not. To the extent that the Examiner has combined these teachings, they cannot stand as a 35 U.S.C. § 102(a) rejection.

The Examiner rejects claims 58-68 under 35 U.S.C. § 102(b) as anticipated by the admitted prior art. Applicant traverses the rejection and requests further consideration and reexamination.

The Examiner applies Levy, U.S. Patent 4,985,251, column 18, example 1, for teaching a process for preparing a composition comprising a superabsorbent polymer and the use of "Arosurf® MSF, fatty acid, esters, ethers and alcohols) that function as film forming agents, as a surfactant emulsifier or an insecticidal" citing column 17, lines 42-54. (March 28 Office Action, p.5, lines 1-3) The present response distinguishes the teachings of Levy by amending claim 57 to include organic or inorganic solid lubricants, water containing a lubricant additive, a phosphate, petroleum oil grease, wax or

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synthetic oil lubricant selected from silicones, polyphenyl ethers, silicates, chlorinated aromatics, fluoro carbons and polyglycol lubricants or greases thereof, and petroleum oil greases with the lubricants optionally containing a lubricant additive. The Levy reference does not employ any of these lubricants in combination with a superabsorbent polymer.

The Levy reference also does not teach or suggest the claim 70 coating which comprises a substantially anhydrous coating on at least one surface of two surfaces that frictionally engage one another were the coating is a superabsorbent polymer in combination with the lubricant, and the lubricant comprises a fatty oil, fatty acid, polymerized olefins, organic esters, a soap, petroleum oil or an isostearyl alcohol containing two oxyethylene groups (Arosurf®) with the lubricants optionally containing a lubricant additive. The Levy teaching with regard to the various lubricants of claim 70 specifically does not refer to either a substantially anhydrous coating, or a coating on at least one surface of two surfaces that frictionally engage on another.

Again, the Examiner combines the teachings of Brannon-Peppas with Levy, and to the extent that the Brannon-Peppas reference does not enhance the Levy disclosure, this rejection comprises a 35 U.S.C. § 103(a) rejection and not a 35 U.S.C. § 102(b), and the rejection under 35 U.S.C. §102 cannot stand.

The Examiner also rejects claims 57, 61, 62 and 65 under 35 U.S.C. § 102(b) as anticipated by Geursen et al., WO 93/18223. Applicant traverses the rejection and request further consideration and reexamination. Applicant in traversing the rejection will refer to the U.S. counterpart of Geursen, U.S. Patent No. 5,534,304.

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Geursen discloses a process for treating a substrate such as a fiber or fibrous product with a superabsorbent material. Geursen, without specifically mentioning it, faces a problem of applying a superabsorbent polymer coating to a substrate from a liquid medium. The superabsorbent polymer employed by Geursen does not dissolve in water, so Geursen forms an emulsion (actually a suspension) of the polymer in water by polymerizing the water soluble monomer in a water in oil medium to form the polymer in the aqueous phase of the emulsion (Col. 4, lines 1-16). Geursen uses the emulsion as a coating, and subsequently heat-treats it to drive off the water phase and oil phase, generally a relatively low boiling paraffin hydrocarbon. (Col. 3, lines 15-23). Geursen also discloses commercially available water-in-oil emulsions prepared in the same way, which may also include additives, such as lubricants and emulsifying agents. (Col. 4, lines 17-26; 42-47).

The disclosed aqueous polymerization of the monomer into a superabsorbent polymer appears to prevent Geursen from obtaining a polymer that absorbs greater than about 100 times its weight in water. The analysis of the Geursen examples set out below shows that the reference contains experimental data demonstrating the production of superabsorbent polymers that absorb only about 45 times their weight in water. Geursen therefore lacks any disclosure of how to produce oil in water emulsions of superabsorbent polymers that absorb greater than about 100 times their weight in water.

The reference describes yarns coated with a superabsorbent polymer composition which have a "swelling value" (Col. 7, lines 19-44) defined by a formula (Col. 7, lines 45-51). The swelling value consists of a number that indicates the relative

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water absorbency of the yarn or the yarn coated with the superabsorbent polymer composition.

Again, Geursen does not teach or suggest superabsorbent polymers that can absorb greater than about 100 times their weight in water for the process or product disclosed, as an analysis of the data in columns 9 and 10 bears out. Table A, reports experimental data for the swelling values of yarn samples coated with a water-in-oil emulsion where the yarn is a polyester yarn, with the untreated polyester yarn having a swelling value of 9. Using the formula in col. 7, lines 45-51:

$$\text{swelling value} = \frac{(a - b) \times 100}{b}$$

Arbitrarily setting the weight of the yarn (the value for "a") at 100 grams will give the dry weight of the yarn (the value for "b") as follows:

Example 1 Swelling value of uncoated yarn = 9 (Col. 9, lines 34-35)

$$\frac{100-b}{b} = 0.09$$

b

$$100 = 1.096b$$

$$b = 91.74 \text{ (dry weight of yarn)}$$

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Yarn water absorption = 100 - 91.74 = 8.26

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Example 1

Swelling value of coated yarn = 114 (Col. 9, line 28)

$$\frac{100-b}{b} = 1.14$$

b

$$100 = 2.146b$$

$$b = 46.72 \text{ (dry wt. of yarn and superabsorbent polymer)}$$

$$\text{Coated yarn water absorption} = 100 - 46.72 = 53.28$$

$$53.28 - 8.26 = 45.02 \text{ water absorbed by superabsorbent polymer}$$

$$46.27 \times 2.1\% \text{ polymer (Col 9, line 28)} = 0.97 \text{ superabsorbent polymer on yarn}$$

$$\begin{aligned} \frac{45.02}{0.97} &= 46.3 \quad \text{Superabsorbent polymer absorbs 46.3 times its} \\ &\quad \text{weight in water.} \end{aligned}$$

This shows that 0.97 grams of superabsorbent polymer picked up or absorbed 45.02 grams of water or 46.3 times its weight in water, less than one half of that of Applicant's claimed superabsorbent polymer which absorbs greater than about 100 times its weight in water. The same calculations will show the superabsorbent polymer of experiment 4 (Table B) coated on a nylon-6, 6 yarn absorbs about the same amount of water, i.e., less than about one half Applicant's claimed superabsorbent polymer that absorbs greater than about 100 times its weight in water.

These data from Geursen clearly suggest that the inventors did not combine, and did not know how to combine a lubricant with a superabsorbent polymer that absorbs

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greater than about 100 times its weight in water. Since the reference does not disclose this type of polymer coating or how to produce it, Geursen does not contain an enabling disclosure.

Because Geursen teaches suspensions of superabsorbent polymers (made by emulsion polymerization) that absorb only about 45 times their weight in water, the reference clearly raises the question of how the skilled artisan gets over the hurdle of this water absorbency of 45 to arrive at applicant's lower limit of water absorbency greater than about 100? The reference doesn't provide any information in this regard, and as indicated previously, appears to teach a polymer that precludes these higher limits. The reference clearly lacks an enabling disclosure, and the Examiner has not met the burden of providing evidence that Geursen does in fact show a suspension polymer in an aqueous medium suitable for coating a substrate, where the polymer absorbs greater than about 100 times its weight in water. Lacking this evidence, the rejection cannot stand. In re Lee, 227 F.3d 1338, 61 U.S.P.Q. 2d 1430 (Fed. Cir. 2002)

Additionally, Geursen faced the problem of applying a superabsorbent polymer to yarn, confronted with the problem that the superabsorbent polymers when combined with water was either extremely viscous or gelled. The superabsorbent polymer employed therefore had to have some flowable characteristics in order to apply it as a coating material. Geursen appears to address this problem by adding an electrolyte to the superabsorbent polymer. For example, see the disclosure in column 9, lines 8 et. seq., of Geursen which describes using a sodium salt of the superabsorbent polymer.

Levy, however, discusses this well known technique for reducing the viscosity of a superabsorbent polymer:

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normally, unmixed formulations of superabsorbent polymers and water have a tendency to form gels of such a high viscosity that they are not flowable. An additional technique used to render a viscous superabsorbent polymer composition . . . flowable, is the additional [sic, addition] of varying concentrations of one or more salt(s)/electrolyte(s) such as sodium chloride . . . These salt-s/electrolytes have a tendency to interfere with the hydrogen bonding or reduce the hydrophilic bonding of the water to the gel. Also, superabsorbent polymers . . . absorb less water when electrolytes are present.

Levy, U.S. Patent No. 4,985,251 column 15 on 12-26 (emphasis added).

This further supports the foregoing analysis of the Guersen data, and that Guersen had to obtain a formulation that he could coat onto a textile fiber, particularly a formulation that did not gel. It appears Guersen did this by adding a sodium salt to the superabsorbent polymer to break the gel, and in so doing obtained a flowable formulation, but reduced the water absorbency of the superabsorbent polymer to a value of about 45 times it's weight in water.

Granted Geursen discloses superabsorbent polymers having water absorbencies greater than 100, but the reference does not teach how to apply them to a substrate, other than by way of the examples, where the inventors appear to reduce the water absorbency to about 45 to obtain a reduction in polymer viscosity in order to obtain a composition they can apply to a substrate. The reduction in water absorbency correlates with a decrease in viscosity to make the superabsorbents more flowable, i. e., more readily coated onto a substrate. Again, Geursen appears to do this by adding an electrolyte, such as a sodium salt, to the superabsorbent polymer.

Because Geursen teaches superabsorbent polymers coatings that absorb only about 45 times their weight in water, the reference clearly raises the question of how the skilled artisan gets over the hurdle of this water absorbency of 45 to arrive at applicant's

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lower limit of water absorbency greater than about 100? The reference clearly lacks an enabling disclosure, and the Examiner has not met the burden of providing evidence that Geursen does in fact show a suspension polymer in an aqueous medium suitable for coating a substrate, where the polymer absorbs greater than about 100 times its weight in water. Lacking this evidence, the rejection cannot stand.

The Rejection Under 35 U.S.C. § 103(a) and Traverse

The Examiner rejects claim 58-60, 63-64 and 66-68 under 35 U.S.C. § 103(a) as unpatentable over Geursen as applied to claims 57, 62 and 65 and further in view of Geursen combined with the admitted prior art. Applicant traverses the rejection under 35 U.S.C. § 103(a) for the same reasons set forth above with regard to the traverse of the 35 U.S.C. § 102(b) rejection based on Geursen.

The Examiner rejects claims 57, 59 and 65-68 under 35 U.S.C. § 103(a) as unpatentable over Gaa et al., U.S. Patent No. 4,810,576 ("Gaa") or Cossement et al., U.S. Patent No. 5,236,982 ("Cossement"). Applicant traverses rejection and requests further consideration and reexamination.

The Examiner looks to the Gaa and Cossement disclosures for teachings of fiber reinforcing materials with coating or sizing compositions applied to them consisting of solutions of polyacrylates and other polymeric materials or binding agents. The Examiner then argues "that lubricant compositions intrinsically function as a coating when it [sic] contacts [sic] a surface so that it [sic] lubricant properties can be exhibited. Hence, the coating composition function [sic] as a lubricant." (March 28, Office Action, page 8, first full paragraph).

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Applicant understands the Examiner to argue that if the lubricant composition functions as a coating, then a coating composition functions as a lubricant, with both Gaa and Cossement disclosing coating compositions on a fiber or yarn substrate.

Applicant disagrees. Because a lubricant functions as a coating it does not necessarily support the position that a coating composition functions as a lubricant. For example, fibers coated with a rubber latex to apply a rubber coating over the fibers does not amount to the application of a lubricant coating on the fiber. In fact, frictionally engaging such a coated fiber with another surface would impede movement of the two surfaces against each other.

The other aspect of the Examiner's argument has some merit. Applicant would generally agree that the application of a lubricant to a surface would result in providing a coating on the surface. But, as pointed out above, the converse, i.e., applying a coating to a surface would result in a lubricated surface, does not necessarily follow. It depends on the nature of the coating.

In any event, neither Gaa nor Cossement teach a superabsorbent polymer, let alone a superabsorbent polymer in combination with a lubricant. Gaa describes various polymers in column 6, lines 53 et. seq. such as polyoxyethylenes, polyacrylic acids neutralized with a base, polyacrylamides, polyvinylpyrrolidones and polyvinyl alcohols as well as blends and mixtures thereof. The reference does not describe any of these polymers as superabsorbent polymers that can absorb greater than 100 times their weight in water. Similarly, Cossement describes polyurethane/isocyanate emulsions, all polymers of acrylic acid and an amino silane in water as an aqueous coating composition. The reference neither teaches nor suggests the use of superabsorbent

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polymers absorbing greater than 100 times their weight in water in combination with a lubricant.

The Provisional Double Patenting Rejection

The Examiner provisionally rejects claims 57-63 under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 29-43 of copending application Serial No. 09/357,957 and claims 57-71 of copending application Serial No. 09/359,809.

Applicant traverses the rejection since the patent office has not indicated whether any of the above applications as well as the present application contain patentable subject matter and applicant cannot take a position regarding the obviousness type of rejection until such time as the patent office indicates the allowability of the claims in these applications.

Applicant should not be required to file a terminal disclaimer in the present application since the patent office may not allow the copending applications which form the basis of the double patenting rejection. When a provisional double patenting rejection is the sole remaining rejection in an application of the rise and condition for allowance, the MPEP states that the Examiner should withdraw the rejection in the application and permit it to issue as a patent. MPEP § 804(I)(B) p.800-15 July 19, 1998.

The References Provide No Motivation to Combine Their Teachings

The Examiner "has to point to some teaching, suggestion or motivation in the prior art to select and combine the references that . . . [she] relied on to show

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obviousness." In re Lee, 61 U.S.P.Q. at 1434 (emphasis added). "When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to select and combine the references relied on as evidence of obviousness...the central question is whether there is a reason to combine references." Lee, 61 U.S.P.Q. at 1435 (emphasis added) (citation omitted). Applicant submits that the Examiner has not pointed to anything in the cited references that would lead a person with ordinary skill in the art to combine their teachings.

The combination of references does not make applicants' invention obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. Section 2143.01 citing In re Mills, 916 F.2d 680, 16 U.S.P.Q. 2nd 1430 (Fed. Cir. 1990). Also, there must be some reasonable expectation of success (M.P.E.P. Section 2143.02, and cited authorities) and that some advantage or expected beneficial result would have been produced by their combination. (M.P.E.P. Section 2144 citing In re Sernaker, 702 F.2d, 989, 994-95, 217 U.S.P.Q. 1,

In rejecting the claims on a combination of references, the Examiner has Levy teaching a superabsorbent polymer in combination with a bioactive material, Hopkins teaching a polymer such as cellulose acetate with a plasticizer, as a matrix for a superabsorbent material, and Geursen teaching a superabsorbent polymer absorbing only about 45 times its weight in water applied to a substrate as a water in oil emulsion, followed by removing the oil phase (a paraffinic hydrocarbon) by evaporation. Adding The Admitted Prior Art to the mix gives the Examiner citations to show the art contains teachings of superabsorbent polymers that absorb greater than about 100 times their weight in water, as well as extensive disclosures of lubricant materials and technology,

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but applicant disclosed this in the written description when he filed the application. Where then, in all of these references, can a skilled artisan find a teaching, suggestion, or motivation to pick and chose from them, and then combine the pieces to arrive at applicant's invention, that broadly comprises a lubricant in combination with a superabsorbent polymer that absorbs greater than about 100 times its weight in water? Applicant submits the skilled artisan couldn't without applicant's disclosure in front of them.

A 35 U.S.C. § 103 rejection cannot stand if it amounts to taking applicant's "claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention." W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1551, 220 U.S.P.Q. 303 (Fed. Cir. 1983).

The Examiner Has Improperly Relied on Non-Analogous Art to Make The Rejection

By combining the teachings of the various references under 35 U.S.C. § 103, the Examiner has relied on non-analogous art since the references are not related to the same field of endeavor or reasonably pertinent to the problem addressed by the inventor. In re Clay, 966 F.2d, 656, 23 U.S.P.Q. 2d at 1058 (Fed. Cir. 1992).

The Levy patent relates to biological control agents as well as delivering these biological control agents to a targeted environment. Hopkins also falls into the category of non-analogous art since the reference describes a polymeric matrix for a superabsorbent polymer having no disclosed utility.

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A person with ordinary skill in the lubricant art would not consider looking to the biological control arts to develop a product that would fulfill a perceived need in the lubricating arts and vice versa. The combination of references does not relate to the same field of endeavor nor is it "reasonably pertinent to the problem with which the inventor is involved." Clay, 966, F.2d at 658, 23 U.S.P.Q. 2d at 1060. The lubricant arts do not fall into the same field of endeavor as the biological control agents and processes of the Levy patent. Clearly, the Levy biological control agents and processes are not reasonably pertinent to the problem, which the inventor, Dr. Levy is concerned with in the present application, i.e., lubricants and lubricating processes.

The fact that Dr. Levy, the inventor of the present application and the inventor in the Levy patents, has worked in both the fields of bioactive materials and lubricants does not provide the nexus between the superaborsent polymers/ biological control agents and superabsorbent polymers/lubricants. In the first instance, the present application is not prior art that can be used to show the level of skill in a superabsorbent polymer art. More important, the total lack of evidence supporting a relationship between biological control agents and lubricants forecloses any argument that these two areas comprise related fields of scientific or technological endeavor. The similarity has to reside in the nature of the scientific or technological fields, and not the fact that one scientist with multiple disciplines works in both. The inquiry is whether the field of delivering biological control agents to a target area suggests lubricants or vice versa.

Clearly, they do not.

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Conclusions

Applicant requests the Examiner to withdraw the rejection in view of the foregoing amendments and remarks and pass the application to issue. If entry of this amendment requires an extension of time pursuant to 37 C.F.R. § 1.136 and payment of an extension fee, or other fee, not accounted for above, applicant's attorneys requests such an extension and payment of any fees due from their deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 23, 2002

By: 
Robert J. Eichelburg
Reg. No. 23,057

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PATENT
Customer No. 22,852
Attorney Docket No. 01064.0011.07000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Richard LEVY) Group Art Unit: 1714
Serial No.: 09/779,588) Examiner: M. Medley
Filed: February 9, 2001)
For: SUPERABSORBENT POLYMER-)
LUBRICANT COMPOSITIONS ON)
SUBSTRATE)

Commissioner for Patents
Washington, DC 20231

Sir:

SUBMISSION OF MARKED UP VERSION OF AMENDMENTS TO THE CLAIMS
PURSUANT TO 37 C.F.R. § 1.121

Applicants submit the following marked up version of amendments to the claims pursuant to 37 C.F.R. § 1.121 to accompany the amendment in response to the respond to the March 28, 2002 Office Action.

IN THE CLAIMS:

57. (Amended Once) A coating formed on the surface of a substrate, said coating comprising a superabsorbent polymer further comprising a lubricant wherein said lubricant is a solid organic lubricant, a solid inorganic lubricant, water containing a lubricant additive, a phosphate, petroleum oil grease, wax, a synthetic oil lubricant selected from silicones, polyphenyl ethers, silicates, chlorinated aromatics, fluorocarbons and polyglycol lubricants or greases thereof, wherein said lubricants optionally containing a lubricant additive.

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68. (Amended Once) The coating of claim 67 wherein said coating comprises a product produced by the process of combining said superabsorbent [superabosrbent] polymer, said lubricant and said binder, and said viscosity modifying agent when present.

Conclusions

If entry of this submission requires an extension of time pursuant to 37 C.F.R. § 1.136 and payment of an extension fee, or other fee, not accounted for above, applicant's attorneys requests such an extension and payment of any fees due from their deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 23, 2002

By:


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